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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,850	12/14/2000	Jose Raul San Miguel Gomez	JG-GV-4999 /5	8133

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EXAMINER

ARYANPOUR, MITRA

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 12/03/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/622,850

Applicant(s)  
Gomez et al.

Examiner  
Mitra Aryanpour

Art Unit  
3711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 14, 2000
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Dec 14, 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☒ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

Art Unit: 3711

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the U.S.A. on 12/14/2000. It is noted, however, that applicant has not filed a certified copy of the Spanish application as required by 35 U.S.C. 119(b).

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 8.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "10" and "4" have both been used to designate heel.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "1" has been used to designate both base and body.

Correction is required for the above objections.

### ***Specification***

5. The disclosure is objected to because of the following informalities: Reference has been made to practice the sport of "football", a more appropriate term to use would be "soccer" since "football" may be misconstrued to be "American football".

Art Unit: 3711

6. **37 CFR 1.52(b)** requires that the pages of the specification including claims and abstract must be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. The lines of the specification, and any amendments to the specification, must be 1 ½ or double spaced. Appropriate correction is required for the above objections.

***Claim Objections***

7. Claims 1-6 are objected to because of the following informalities: In claims 1-6 "football" should be changed to "soccer"; in claim 1, line 1, --An-- should be inserted before "Apparatus" and "Apparatus" should be lower case; in claims 2-6, line 1, --The-- should be inserted before "Apparatus" and "Apparatus" should be lower case.

Appropriate correction is required for the above objections.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the said sport" in line 3. There is insufficient antecedent basis for this limitation in the claim. Claim 1 recites the limitation "the practice" in line 3. There is

Art Unit: 3711

insufficient antecedent basis for this limitation in the claim. Claim 1 recites the limitation "the ankle" in line 10. There is insufficient antecedent basis for this limitation in the claim. Claim 1 recites the limitation "the player" in line 8. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by **Thompson (3,986,221)**.

Note that in accord with the Court's instructions in *Kropa v. Robie* 187 F.2d 150, 88 USPQ 478, and other decisions, no weight is being given to the statements of intended use in the preamble.

Thompson discloses an apparatus (10) characterized by the fact that it is composed of a body (12) that reproduces the shape and size of a human foot, up to the top of the foot, while from the top of the body (12) a short arm (30) emerges, this ending in a handle (36) arranged noticeably parallel to the axis of the body (12), in such a way that the player uses the said handle (36) to manipulate the apparatus, with the body (12) with the movement of the wrist.

Art Unit: 3711

Thompson as disclosed above meets the structural limitations of the claimed invention. Thompson's device inherently is capable of being used by a person in a wheelchair allowing the disabled person to practice knocking or hitting a ball in a game such as soccer.

Regarding claim 2, Thompson's device has a base body (12) which is symmetrical with respect to an imaginary longitudinal, vertical and middle plane, while both sides are concavely curved to conform to the shape of boot and which can be used with the right or left hand.

Regarding claims 3 and 5, Thompson is composed of a plurality of parts (see figure 1). It is also well known in this art to have the shoe or boot tree made of one piece.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Thompson (3,986,221)** in view of **Cumbie (5,040,813)**.

Thompson as disclosed above does not provide means for attachment. Cumbie shows an accessory holder and mount for wheelchairs (see figures 5-12, column 3, lines 61-68 and column 4, lines 1-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

Art Unit: 3711

invention was made to have used one of the accessory holders of Cumbie, such as the one in figure 8, in order to be able to carry the device of Thompson when used by a person in a wheelchair.

The apparatus is equipped with a support (7), that is suitable for affixing to any suitable point of a wheelchair, and which allows the apparatus itself to be temporarily held to leave the upper limbs free during the movement of the wheelchair.

**Note:** The structural limitation of the device as claimed, is old and well know. However, the specific method of use in conjunction with the specific structure of the claimed device may distinguish patentably over the art of record in this application.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McGrann (see figure 1); Jurkiewicz (see figure 1); Such (see figure 5); Lay (see figure 1); Magnum (see figures 1 and 4A); Steele et al (see figure 1); Doucet (see figure 8); Davis (see figure 4); Bryan et al (see figure 1); Raubuck et al (see figures 2 and 4); Raubuck et al (see figures 2, 4 7 and 10); Wilds (see figure 1); Miller (see figures 1 and 8); Schnelle (see figures 1 and 5); Saderne (see figure 1).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is (703) 308-3550. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.


Art Unit: 3711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached at (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

MA

November 9, 2001

  
Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700



Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a)

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.